UNITED STATES PATENT AND TRADEMARK OFFICE

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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte HITAN S. KAMDAR, RUSSELL A. PATENAUDE, ANTHONY
J. SUMCAD, SHPETIM VELIU, and BRAD T. REESER

_____

Appeal 2009-009076
Application 10/786,980
Technology Center 2800

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Before ALLEN R. MACDONALD, ELENI MANTIS MERCADER, and
CARL W. WHITEHEAD, JR., *Administrative Patent Judges.*

WHITEHEAD, JR., *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Introduction

Appellants appeal under 35 U.S.C. § 134(a) from a final rejection of claims 1-5, 7-9, and 19-26. Appeal Brief 4. We have jurisdiction under 35 U.S.C. § 6(b) (2002). We affirm-in-part.

Exemplary Claim

Exemplary independent claim 1 under appeal reads as follows:

1. A method of providing vehicle diagnostic function within a mobile vehicle communication system, comprising:

configuring a primary diagnostic script for a telematics equipped mobile vehicle wherein the primary diagnostic script recreates known problem sequences when executed;

providing the primary diagnostic script to the mobile vehicle; executing the primary diagnostic script; and

storing diagnostic data based on the executed primary diagnostic script such that the stored diagnostic data is made available for analysis.

Rejection on Appeal

Claims 1-5, 7-9, and 19-26 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marko (U.S. Patent Number 6,745,151 B2; filed June 1, 2004), Sonnenrein (U.S. Patent Application Number 2005/0154500 A1; filed June 14, 2005) and Shirane (U.S. Patent Number 5,491,631; filed February 13, 1996). Answer 2-7. Claims 6 and 10-18 have been cancelled. Appeal Brief 4.

Issues

1. As far as independent claims 1 and 19 are concerned, the dispositive issue is: does the combination of Marko, Sonnenrein and Shirane disclose wherein the primary diagnostic script recreates known problems sequences?

2. As far as independent claim 20 is concerned, the dispositive issue is: does Marko fail to show determining a primary diagnostic script that "includes a *plurality of diagnostics scripts* that are determined *based on diagnostic options?*"

ANALYSIS

Independent Claims 1 and 19

Appellants argue that the Examiner's reliance upon the Shirane patent (column 10, line 50 – column 11, line 14) to disclose the claim limitation wherein a <u>primary diagnostic script recreates known problem sequences</u> is improper because the Examiner has failed to establish a prima facie case that Shirane teaches or renders the limitation obvious. Appeal Brief 9; Answer 4. Appellants argue that "the claimed method *purposely causes some type of undesirable vehicle system operation* so that the results can be observed and analyzed." Appeal Brief 10. The Examiner finds Shirane (column 10, line 50 – column 11, line 14) teaches that the fault diagnostic program detects and analyze fault when the fault diagnostic program is executed is a clear teaching of a primary diagnostic script recreating known problem sequences as claimed. Answer 7.

Appellants argue in the Reply Brief[1] in regard to Shirane that:

> In this regard, Appellant notes that a diagnostic script that
> recreates known problem sequences is not the same as <u>any</u>
> diagnostic program or script (such as a typical one that reads
> fault codes or sensors). Rather, it is a script that is configured
> based on at least one problem sequence that is already known
> and, furthermore, is a script that causes the vehicle to recreate
> this sequence.

Reply Brief 2.

We find the Appellants' arguments to be persuasive because a diagnostic script that recreates known problem sequences is not the same as any diagnostic program or script and therefore Shirane does not teach or suggest the claim limitation "recreate known problem sequences when executed." We will not sustain the Examiner's rejection of independent claims 1 and 19, as well as, dependent claims 2-5 and 7-9.

Independent Claim 20

As far as independent claim 20 is concerned, the Appellants argue that the rejection is improper because Marko fails to show determining a primary diagnostic script that "includes a *plurality of diagnostics scripts* that are determined *based on diagnostic options.*" *See* Appeal Brief 12. Appellants then cites to his Specification to present an exemplary embodiment of the claimed feature. *Id.* We find that the cited embodiment is a non-limiting example and does not distinguish the claim either way over the prior art. Although giving claims their broadest reasonable interpretation must take into account any definitions given in the Specification, *In re Morris*, 127

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[1] We are referring to the Reply Brief filed March 10, 2008.

F.3d 1048, 1054 (Fed. Cir. 1997), it is improper to read into the claims limitations from examples given in the Specification. *In re Zletz*, 893 F.2d 319, 321-22 (Fed. Cir. 1989). *See also Phillips v. AWH Corp.*, 415 F.3d 1303, 1323 (Fed. Cir. 2005)

> ("[A]lthough the specification often describes very specific embodiments of the invention, we have repeatedly warned against confining the claims to those embodiments . . . In particular, we have expressly rejected the contention that if a patent describes only a single embodiment, the claims of the patent must be construed as being limited to that embodiment")

(citations omitted).

Appellants further argue that Marko (column 8, lines 26-30) simply states that scripted algorithms and histogram reference patterns can be updated with new or modified versions and there is nothing in the Marko passage that suggests that *a single primary diagnostic script can have a plurality of diagnostic scripts* as recited in claim 20. Appeal Brief 13. Appellants conclude that in claim 20 it is clear that the diagnostic options used in the determination of the diagnostic scripts are used in the determination of the primary diagnostic script and that Marko makes no suggestion of utilizing any types of diagnostic options in the creation of a primary diagnostic script. *Id.* The Examiner maintains that Marko inherently teaches a plurality of diagnostic scripts (scripted algorithms 62) that are determined based upon diagnostic options (data subset). Answer 9; Marko (column 8, lines 26-30).

We do not find Appellants' arguments to be persuasive because there is no apparent distinction between Marko's algorithms and the generic scripts in claim 20. Further, we will sustain the Examiner's rejection of

dependent claims 21-26. *See In re Nielson*, 816 F.2d 1567, 1572 (Fed. Cir. 1987) (dependent claims, not argued separately, fall with the independent claim, even though the dependent claims were rejected based on additional (or different) references).

DECISION

The Examiner erred in rejecting claims 1-5, 7-9, and 19 under 35 U.S.C. § 103(a).

The Examiner did not err in rejecting claims 20-26 under 35 U.S.C. § 103(a).

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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